III. REMARKS

As an initial matter, while the Examiner has acknowledged Applicant's priority claim, the Examiner contends that a certified copy of Applicant's foreign priority document, namely, Japanese Patent Application No. 2004-025293 of February 2, 2004 , has not been received (Office Action, mailed September 23, 2008, at 2, lines 14-16). Applicant reminds the Examiner that the present application is a U.S. National Phase Application of International Patent Application No. PCT/JP2004/003866 filed March 22, 2004, which claims priority on Japanese Patent Application No. 2004-025293, filed February 2, 2004. Therefore, the United States Patent and Trademark Office (USPTO) should receive copies of the certified copies of Applicant's Japanese priority document from the International Bureau. Therefore, Applicant respectfully requests that the Examiner check again for the copies of the certified copies of Japanese Patent Application No. 2004-025293, which the USPTO should have received from the International Bureau, and then acknowledge receipt of these documents from the International Bureau.

The Abstract has been amended to address minor informalities.

Claims 5 and 6 have been cancelled without prejudice. Claims 1-4 and 7-10 have been amended to improve grammar, form, punctuation, and clarity, which has no further limiting effect on the scope of the claims. Independent claims 1 and 7 have been further amended to recite "wherein the stored information includes addresses of the registered users in the first virtual community" as supported on page 6, lines 2-21, and on page 10, lines 22-28, and on page 12, lines 9-12, and by Figure 2, of Applicant's disclosure as originally filed. Independent claims 1 and 7 have also been amended to recite "wherein the virtual tag community mounted on the website is only a portion of the first virtual community

corresponding to the address of a third user who owns the website mounting the virtual tag community" as supported on page 9, line 15, to page 10, line 21, of Applicant's specification as originally filed.

Independent claims 8 and 9 have also been amended to recite "wherein the virtual tag community mounted on the website is only a portion of the first virtual community corresponding to the address of a fourth user who owns the website mounting the virtual tag community" as supported on page 9, line 15, to page 10, line 21, of Applicant's specification as originally filed. Independent clam 9 has been further amended to recite

> "a virtual community providing program, stored on a computer readable storage medium, for causing a computer connected to a user terminal via a network to provide a virtual community for a user who is using the user terminal, wherein the computer readable storage medium is an applications database of a virtual community system,"

as supported on page 3, line 28, to page 4, line 6, and on page 5, line 18, to page 6, line 9, and on page 13, lines 21-28, of Applicant's specification as originally filed. Applicant directs the Examiner's attention to page 13, lines 27-28, which states that "programs can be installed on each computer directly by using storage media and can be installed via the network." As evident from page 6, lines 7-9, of Applicant's specification, an "applications database" is a storage medium in which applications (i.e., programs) executing the virtual community are stored.

The present amendment adds no new matter to the above-captioned application.

A. The Invention

The present application pertains broadly to a community providing server providing a virtual community for a user who has a user terminal connected to the server via a network,

and to a virtual community system providing a virtual community for a user, and to a virtual community providing method, and to a virtual community providing program, such as relates to a virtual community that may be offered, for example, via the Internet. In accordance with an apparatus embodiment of the present invention, a community providing server is provided that includes features recited by independent claim 1. In accordance with another apparatus embodiment of the present invention, a virtual community system is provided that includes features recited by independent claim 7. In accordance with a method embodiment of the present invention, a virtual community providing method is provided that includes steps recited by independent claim 8. In accordance with yet another embodiment of the present invention, a virtual community providing program is provided that includes features recited by independent claim 9. Various other embodiments, in accordance with the present invention, are recited by the dependent claims.

An advantage provided by the various embodiments of the present invention is that a virtual community system, server, method, and/or program is provided that effectuates a virtual community that is more convenient to use and that facilitates effective advertising.

B. The Rejections

Claim 9 stands rejected under 35 U.S.C. § 101 for allegedly failing to recite statutory subject matter.

Claims 1, 2 and 7-10 stand rejected under 35 U.S.C. § 103 as allegedly unpatentable over Matsuda (U.S. Patent Application Publication No. US 2002/0054094 A1, hereafter the "Matsuda Publication") in view of Parry (U.S. Patent Application Publication No. US 2002/0178186, hereafter the "Parry Publication"). Claim 3 stands rejected under 35 U.S.C. §

103 as allegedly unpatentable over the Matsuda Publication in view of the Parry Publication, and further in view of DuVal (U.S. Patent 5,818,836, hereafter the "DuVal Patent"). Claim 4 stands rejected under 35 U.S.C. § 103 as allegedly unpatentable over the Matsuda Publication in view of the Parry Publication, and further in view of Olivier (U.S. Patent 6,480,885, hereafter the "Olivier Patent"). Claims 5 and 6 stand rejected under 35 U.S.C. § 103 as unpatentable over the Matsuda Publication in view of the Parry Publication, and further in view of Nagatomo (U.S. Patent 6,487,557 B1, hereafter the "Nagatomo Patent).

Applicant respectfully traverses the Examiner's rejections and requests reconsideration of the above-captioned application for the following reasons.

C. Applicant's Arguments

The Examiner objects to claims 1-10 on the grounds that the phrases "virtual tag community" and "a website of the registered user" are indefinite. Applicant disagrees. The phrase "virtual tag community" pertains to a subset of the virtual community that has been tagged with an HTML tag (i.e., a community tag) so that this subset of the virtual community can be mounted on a website without having to access a specified homepage of the virtual community (See, e.g., Applicant's original specification, at 5, lines 18-26).

The Examiner objects to the phrase "a website of the registered user;" however, the Examiner has taken the phrase out of context. Claim 1, for example, recites "mounting a virtual tag community on a website of a registered second user." A person of ordinary skill in the art would understand this phrase to mean that the website is operated and/or controlled by a registered second user and that a virtual tag community is mounted on this website. A person of ordinary skill in the art would realize that the term "mounting" means "loading"

(See, e.g., COMPUTER PROFESSIONAL'S DICTIONARY 232 (1990)). Thus, a person of ordinary skill in the art would instantly realize that the phrase "mounting a virtual tag community on a website of a registered second user" means "[loading] a virtual tag community on a website of a registered second user," which is not indefinite.

i. The Section 101 Rejection

The Federal Circuit, with the acquiescence of the Commissioner of Patents and Trademarks, has ruled that computer programs embodied in a tangible medium, such as floppy disks, are patentable subject matter under 35 U.S.C. § 101. In re Beauregard, 35 U.S.P.Q.2d 1383 (Fed. Cir. 1995). Therefore, independent claim 9 is patentable subject matter under 35 U.S.C. § 101 because the subject matter of claim 9 pertains to a "virtual community providing program, stored on a computer readable storage medium...wherein the computer readable storage medium is an applications database of a virtual community system."

For all of the above reasons, claim 9 recites patentable subject matter under 35 U.S.C. § 101.

ii. The Section 103 Rejections

A prima facie case of obviousness requires a showing that the scope and content of the prior art teaches each and every element of the claimed invention, and that the prior art provides some teaching, suggestion or motivation, or other legitimate reason, for combining the references in the manner claimed. KSR International Co. v. Teleflex Inc., 127 S.Ct. 1727, 1739-41 (2007); In re Oetiker, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992). In this case, the Examiner

has failed to establish a prima facie case of obviousness against Applicant's claimed invention because the combination of the Matsuda Publication, the Parry Publication, the DuVal Patent, the Olivier Patent, and the Nagatomo Patent fails to teach, or suggest, each and every limitation recited by claims 1-4 and 7-10.

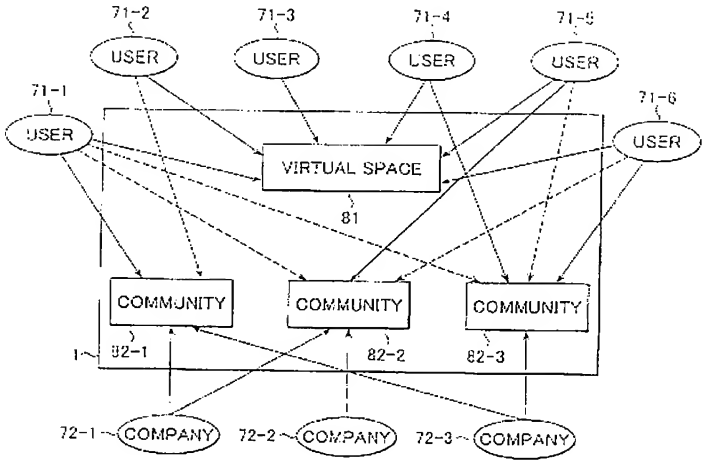
iii. The Matsuda Publication

The Matsuda Publication discloses an "information processing apparatus, information processing method, service providing system, and computer program thereof," wherein the invention allows the exchange of community cards within a virtual space, and a display screen shown on the display section of the user terminal device is composed of a virtual space display for displaying three-dimensional objects in a virtual space, and a list window of belongings displayed by the user's own community cards (See Abstract of the Matsuda Publication, and Figures 7 and 9). The Matsuda Publication discloses that the user can move freely within the virtual space while referring to the virtual space display, and when conversing with other users within the virtual space and when the user wants to let another user participate in the community the user himself belongs to, the user can present community cards corresponding to the avatar, to a user for newly participating in the community, by drag-and-drop of any of the community cards on the avatar (See Abstract of the Matsuda Publication).

A person of ordinary skill in the art would instantly realize that the Matsuda Publication discloses a virtual community (See, e.g., Matsuda Publication, Figure 5, reproduced below for the Examiner's convenience). As admitted by the Examiner (Office

Action, dated September 23, 2008, at 5, line 21, to 6, line 2; at 8, lines 1-3), the Matsuda Publication does not teach, or suggest, (i) "a control means for issuing, for the purpose of mounting a virtual tag community on a website of a registered second user, a community tag that is to be inserted in HTML data constituting the website" as recited by independent claims 1 and 7, (ii) "issuing a community tag, by the community providing server, for a second user who accesses the community providing server and registers with the virtual community in

FIG.5



order to mount a virtual tag community on a website of a registered third user" as recited by independent claims 8 and 9. However, the Matsuda Publication also does not teach, or suggest, (iii)

> "wherein the virtual tag community mounted on the website is only a portion of the first virtual community corresponding to the address of a...user who owns the website mounting the virtual tag community"

as recited by claims 1 and 7-9.

As further admitted by the Examiner (Office Action, dated September 23, 2008, at 9, lines 8-9; and at 10, lines 3-21), the Matsuda Publication does not teach, or suggest, (iv)

> "when a fifth user who has not logged into the first virtual community accesses the website mounting the virtual tag community, the control means performs control to show a specific character that indicates the fifth user is not in a logged-in state in the virtual tag community"

as recited by claim 3, and (v)

> "the user management information database stores an address of the website of the third user owning the website mounting the virtual tag community among the registered users, and the control means provides information of the address of the website for a fourth user via the virtual tag community"

as recited by claim 4.

iv. The Parry Publication

The Parry Publication discloses a "remote URL munging business method" wherein the business method provides a remotely hosted service by an application service provider (ASP) wherein the hosted service is seamlessly integrated into a customer document at a user location (See Abstract of the Parry Publication). According to the Parry Publication, a system for providing the business method includes a combination of novel JavaScript technology and URL munging, wherein, for example, an administrative interface may facilitate the insertion of a line of static JavaScript code into a customer's Web page (See Abstract of the Parry Publication). The Parry Publication discloses that the code may interpret a munged URL and pass the munged URL to an ASP server, and the ASP server may extract session variables that were encoded in the munged URL (See Abstract of the Parry Publication). The Parry Publication discloses that the ASP server may generate a dynamic JavaScript program that displays the hosted service, e.g., a hosted site search engine, and that the hosted service may thereby be written directly into the customer's Web page so that the Web user is not aware that the service is hosted remotely (See Abstract of the Parry

Publication). Thus, a person of ordinary skill in the art would instantly realize that the Parry Publication discloses a site search engine that is mounted on a customer's website (See, e.g., Parry Publication, ¶¶ [0098] to [0100]).

As admitted by the Examiner (Office Action, dated September 23, 2009, at 9, lines 8-9; and at 10, lines 3-21), the Parry Publication does not teach, or even suggest, (i)

> "when a fifth user who has not logged into the first virtual community accesses the website mounting the virtual tag community, the control means performs control to show a specific character that indicates the fifth user is not in a logged-in state in the virtual tag community"

as recited by claim 3, and (ii)

> "the user management information database stores an address of the website of the third user owning the website mounting the virtual tag community among the registered users, and the control means provides information of the address of the website for a fourth user via the virtual tag community"

as recited by claim 4. However, these are not the only deficiencies in the disclosure of the Parry Publication, which also does not teach or suggest (iii)

> "wherein the virtual tag community mounted on the website is only a portion of the first virtual community corresponding to the address of a...user who owns the website mounting the virtual tag community"

as recited by claims 1 and 7-9.

v. The DuVal Patent

The DuVal Patent discloses a "method and apparatus for anonymous voice communication using an online data service," which pertains to an anonymous telephone communication system that includes an anonymous voice system, which can establish an anonymous telephone communication through a circuit switched network (CSN), (See Abstract of the DuVal Patent). The DuVal Patent discloses that, when in operation, (a) two

parties place separate telephone calls to the anonymous voice system through the CSN, then (b) the parties enter matchcodes through their telephone keypads, (c) the anonymous voice system compares the matchcodes entered by the parties and connects the telephone calls if the matchcodes match (See Abstract of the DuVal Patent). The system disclosed by DuVal may include an on-line data service that establishes electronic communication between the parties through corresponding data terminals, and the data terminals may have resident anonymous voice input commands that can be selected by the parties (See Abstract of the DuVal Patent). According to the DuVal Patent, the on-line data service transmits a connect command to the anonymous voice system that dials the two parties, or waits for the parties to dial the system, and then connects the parties, and the anonymous voice system sends a disconnect command to the on-line data service when the parties hang up (See Abstract of the DuVal Patent). The disconnect command can be used by the online service to bill the parties for using the anonymous voice service, and the system also stores a couple record during the first anonymous call recording the matchcode and the telephone numbers of both parties so that, subsequently, either party may initiate an anonymous call to the other party without prior coordination (See Abstract of the DuVal Patent).

However, the DuVal Patent does not teach, or suggest, "when a fifth user who has not logged into the first virtual community accesses the website mounting the virtual tag community, the control means performs control to show a specific character that indicates the fifth user is not in a logged-in state in the virtual tag community" as recited by claim 3. The Duval Patent discloses an icon (108), as shown in Figure 4 (reproduced below for the Examiner's convenience), for initiating an anonymous phone call (DuVal Patent, col. 9, lines 1-7). A person of ordinary skill in the art would instantly realize that the icon (108)

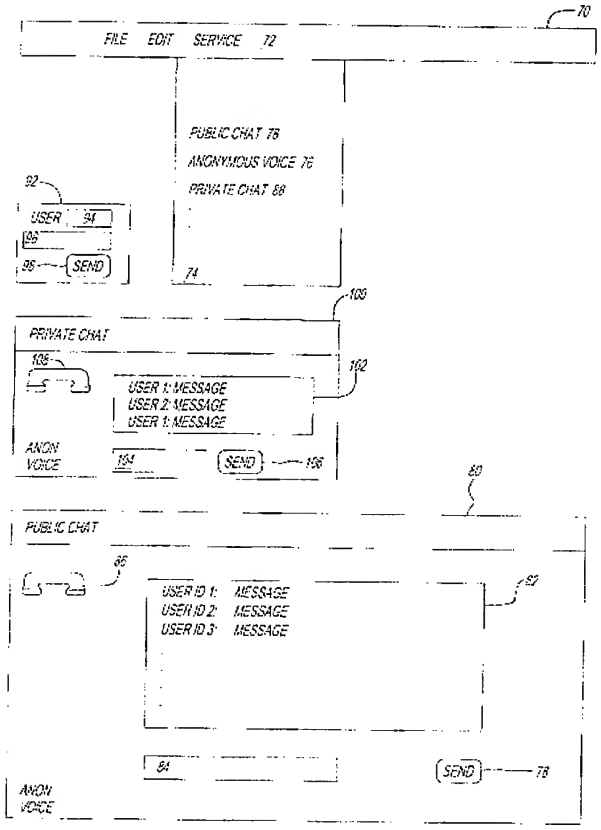


FIG. 4

disclosed by the DuVal Patent does not pertain to "a specific character that indicates the fifth user is not in a logged-in state in the virtual tag community" as recited in claim 3 because icon (108) is used to initiate a telephone call. Icon (108) does not indicate whether or not the user is presently logged in to the anonymous telephone communication system because the caller has no way of knowing if the callee is already logged into the system and is on a call with a third party using the system.

For all of the above reasons, the DuVal Patent does not teach, or suggest, "the control means performs control to show a specific character that indicates the fifth user is not in a logged-in state in the virtual tag community" as recited by claim 3.

vi. The Olivier Patent

The Olivier Patent discloses "dynamically matching users for group communications based on a threshold degree of matching of sender and recipient predetermined acceptance criteria," wherein the method enables users to exchange group electronic mail by establishing individual profiles and criteria, for determining personalized subsets within a group (See Abstract of the Olivier Patent). According to the Olivier Patent, users establish subscriptions to an electronic mailing list by specifying user profile data and acceptance criteria data to screen other users, and when a user subscribes a web server establishes, and stores, an individualized recipient list including each matching subscriber and their degree of one-way or mutual match with the user (See Abstract of the Olivier Patent). The Olivier Patent discloses that when the user then sends a message to the mailing list, an email server retrieves 100% her matches and then optionally filters her recipient list down to a message distribution list using each recipient's message criteria, and the message is then distributed to matching users (See Abstract of the Olivier Patent). Additionally, email archives and information contributions from users are stored in a database (See Abstract of the Olivier Patent). According to the Olivier Patent, the web server creates an individualized set of web pages for a user from the database, containing contributions only from users in his recipient list (See Abstract of the Olivier Patent). In other embodiments disclosed by the Olivier Patent, users apply one-way or mutual criteria matching and message profile criteria to other group forums, such as web-based discussion boards, chat, online clubs, USENET newsgroups, voicemail, instant messaging, web browsing side channel communities, and online gaming rendezvous (See Abstract of the Olivier Patent).

vii. The Nagatomo Patent

The Nagatomo Patent discloses a "network-access management system and method applied to network and computer program product including computer program recorded on storage medium for creating display data" wherein the display data may be displayed as a map (See Abstract of the Nagatomo Patent, and Figure 14).

viii. Summary of the Disclosures

The combination of the Matsuda Publication, the Parry Publication, the DuVal Patent, the Olivier Patent and the Nagatomo Patent does not teach, or suggest, (i)

> "wherein the virtual tag community mounted on the website is only a portion of the first virtual community corresponding to the address of a...user who owns the website mounting the virtual tag community"

as recited by claims 1 and 7-9, and (ii) "the control means performs control to show a specific character that indicates the fifth user is not in a logged-in state in the virtual tag community" as recited by claim 3.

For all of the above reasons, the Examiner has failed to establish a prima facie case of obviousness against claims 1-4 and 7-10.

ix. No Legitimate Reason to Justify the Combination, and No Reasonable Expectation of Success Even if the Combination Were Made

A proper rejection under Section 103 requires showing (1) that a person of ordinary skill in the art would have had a legitimate reason to attempt to make the composition or device, or to carry out the claimed process, and (2) that the person of ordinary skill in the art

would have had a reasonable expectation of success in doing so. PharmaStem Therapeutics, Inc. v. ViaCell, Inc., 491 F.3d 1342, 1360 (Fed. Cir. 2007). In this case, the Examiner has failed to establish a prima facie case of obviousness against Applicant's claimed invention because the Examiner has not established a legitimate reason to combine the disclosures of the Matsuda Publication, the Parry Publication, the DuVal Patent, the Olivier Patent and the Nagatomo Patent and the Examiner has failed to demonstrate that a person of ordinary skill in the art would have had a reasonable expectation of success of arriving at Applicant's claimed invention if the combination was made.

Specifically, the combination of the Matsuda Publication, the Parry Publication, the DuVal Patent, the Olivier Patent and the Nagatomo Patent falls short of Applicant's claimed invention for the reasons discussed above; therefore, the Examiner has failed to demonstrate a reasonable expectation of success even if the combination asserted by the Examiner is made. For the same reasons, the Examiner has failed to establish a legitimate reason for making the combination.

Furthermore, the Matsuda Publication pertains to a virtual community and the Parry Publication discloses a site search engine mounted on a customer's website. Thus, even if the disclosures of the Matsuda Publication and the Parry Publication were combined, a person of ordinary skill in the art would have no guidance regarding how to mount a virtual community on a customer's website.

For all of the above reasons, the Examiner has failed to establish a prima facie case of obviousness against claims 1-4 and 7-10.

IV. CONCLUSION

In view of the present amendment, claim 9 recites statutory subject matter in compliance with 35 U.S.C. § 101. In addition, the Examiner has failed to establish a prima facie case of obviousness against claims 1-4 and 7-9 because the combination of the Matsuda Publication, the Parry Publication, the DuVal Patent, the Olivier Patent and the Nagatomo Patent does not teach, or suggest, (i)

> "wherein the virtual tag community mounted on the website is only a portion of the first virtual community corresponding to the address of a...user who owns the website mounting the virtual tag community"

as recited by claims 1 and 7-9, and (ii) "the control means performs control to show a specific character that indicates the fifth user is not in a logged-in state in the virtual tag community" as recited by claim 3, and because the Examiner has not established a legitimate reason to make the combination, and because the Examiner has not demonstrated that a person of ordinary skill in the art would have had a reasonable expectation of success of arriving at the claimed invention if the combination was made.

For all of the above reasons, claims 1-4 and 7-10 are in condition for allowance, and a prompt notice of allowance is earnestly solicited.

The below-signed attorney for applicant welcomes any questions.

Respectfully submitted,

GRIFFIN & SZIPL, P.C.

Joerg-Uwe Szipl
Registration No. 31,799

GRIFFIN & SZIPL, P.C.
Suite PH-1
2300 Ninth Street, South
Arlington, VA 22204

Telephone: (703) 979-5700
Facsimile: (703) 979-7429
Email: GandS@szipl.com
Customer No.: 24203